

REMARKS

Claims 1 and 5-21 are pending and stand ready for further action on the merits. Claims 11-17 have been withdrawn by the Examiner as being drawn to non-elected subject matter. Support steps (vi) and (vii) of claim 1 can be found in the second full paragraph of page 6 of the present specification. Support for the phrase "consisting of a nickel aluminum alloy with molybdenum and/or tin up to 15%" as found in presently amended claim 5 and new claims 18-19, can be found in the first full paragraph of page 4 of the specification. No new matter has been added by way of the above-amendment.

Issues Under 35 USC 112, first paragraph

Claims 5-10 stand rejected under 35 USC 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, has possession of the claimed invention. Applicants respectfully traverse the rejection.

Specifically, the Examiner has objected to claims 9-10 for containing the phrase "a powder Raney catalyst for a fixed bed", and states that Applicants have not shown that they are in

possession of a Raney catalyst crushed into a powder and reactivated for a fixed bed.

On this point, Applicants direct the Examiner's attention to the paragraph bridging pages 6-7 of the specification, wherein Applicants state "Additionally, *used* lump form Raney catalyst may be collected, crushed into powder and then reactivated to be *reused*." (Emphasis added). The Examiner will note that the preceding two paragraphs characterize the "use" of the catalyst in the fixed bed form. Thus, one skilled in the art would come to the reasonable conclusion, that the term "reused" in the paragraph bridging pages 6-7 implies that the crushed powder is possibly used in the fixed bed.

The Examiner objected to claim 5 for containing the term "suitable", and the Examiner asserts that this term renders claim 5 indefinite. In response, Applicants have amended claim 5 by removing the term "suitable".

In view of the above amendments and remarks, Applicants respectfully request the rejection be withdrawn.

Issues Under 35 USC 112, second paragraph

Claims 1 and 5-10 stand rejected under 35 USC 112, second paragraph, as being indefinite for failing to particularly point

out and distinctly claim the subject matter which Applicants regard as the invention. Applicants respectfully traverse the rejection.

The Examiner has objected to claim 1 for containing the phrase "catalyst obtained by using for the hydrogenation under the hydrogen pressure a lump form Raney catalyst". In response, Applicants have amended claim 1 by deleting the phrase "using for the hydrogenation under the hydrogen pressure a lump form Raney catalyst made by".

The Examiner has objected to the phrase "the third step for classifying and activating said quenched lump alloy as it is or once it is broken, collecting said lump form Raney catalyst, crushing into powder, and reactivating". In response, Applicants respectfully submit that the presently amended claim 1 clearly define the process for containing an optional step (iii), i.e., the breaking the quenched lump alloy. It is clear that steps (i), (ii) and (iv)-(viii) are not optional.

The Examiner has objected to claim 5 for containing the phrase "activating said quenched lump alloy or said quenched lump alloy particles to form a Raney catalyst". The Examiner asserts that it is unclear if the steps of breaking and classifying are positively required, and if they are, the quenched lump alloy would no longer be in a lump form. Applicants respectfully submit that the Examiner is confusing the term "breaking" with the term "crushing".

The term "breaking" defines the step of breaking apart distinct lumps which are bonded together. This is in contradistinction to the term "crushing" which implies that a significant portion of the lumps have been mechanically converted into a powder. As such, the Raney catalyst would still be in the lump form after the breaking and classifying steps.

In conclusion, Applicants respectfully submit claims 1 and 5-10 particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Withdrawal of the rejection is respectfully requested.

Issues Under 35 USC 102 and 103(a)

Claims 5 and 7 stand rejected under 35 USC 102(e) as anticipated by **Schuetz et al.** (USP 5,536,694); and claims 5 and 7-8 stand rejected under 35 USC 103(a) as being unpatentable over **Schuetz et al.** Applicants respectfully traverse the rejections.

Applicants respectfully submit that claim 5, as presently amended, is neither anticipated nor rendered obvious by Schuetz et al., since Schuetz et al. fails to teach or suggest a catalyst consisting of a nickel aluminum alloy with molybdenum and/or tin up to 15%. Schuetz et al. requires the use of a binder such as powder, nickel, copper, cobalt or iron (see lines 20-28 of column 5 and the Examples). Additionally, Schuetz et al. requires

additives such as wax powder or aerosil (see lines 54-59 of column 7 and the Examples). Thus, Applicants respectfully request that the rejections be withdrawn.

Claim 6 stands rejected under 35 USC 103(a) as being unpatentable over **Schuetz et al.** and further in view of **Lepper et al** (USP 4,520,211).

The comments regarding the patentability of the present invention over the teachings of Schuetz et al above, are herein incorporated by reference.

The Examiner, aware of the deficiencies of Schuetz et al., has cited Lepper et al. in order to cure the deficiencies. Applicants respectfully submit that Lepper et al. do not cure the deficiencies of Schuetz et al.

Lepper et al teach a ruthenium containing catalyst, see the abstract and Examples. Since Lepper et al. neither teaches nor suggests a catalyst consisting of a nickel aluminum alloy with molybdenum and/or tin up to 15%, Lepper et al. does not cure the deficiencies of Schuetz et al. As such, Applicants respectfully request that the rejection be withdrawn.

Claims 1, 5 and 7-10 stand rejected under 35 USC 103(a) as being unpatentable over **Schuetz et al.** in view of **Raney** (USP

1,628,190), and optionally in view of **Richter** (USP 3,673,116). Applicants respectfully traverse the rejection.

Regarding the patentability of present claim 1, Applicants respectfully submit that the combination of Schuetz et al., Raney and Richter do not render the presently claimed invention obvious, since Schuetz et al., Raney and Richter fail to teach or suggest a reactivation step after the catalyst has been used under hydrogenation conditions. As such, withdrawal of the rejection of claim 1 is respectfully requested.

Regarding the patentability of present claims 5 and 7-10, Applicants respectfully submit that the combination of Schuetz et al., Raney and Richter do not render the present claims obvious, since Schuetz et al., Raney and Richter fail to teach or suggest the use of a catalyst consisting of a nickel aluminum alloy with molybdenum and/or tin up to 15%. As noted above, Schuetz et al. requires the use of either a binder or additives. Furthermore, Richter requires the use of iron, see abstract, and Raney is silent as to the addition of molybdenum and/or tin. As such, Applicants respectfully request the rejection be withdrawn.

Claim 6 stands rejected under 35 USC 103(a) as being unpatentable over **Schuetz** in view of **Raney**, optionally in view of

Richter and further in view of **Lepper et al.** (USP 4,520,211). Applicants respectfully traverse the rejection.

The above-comments regarding the patentability of the present invention over the combined teachings of Schuetz et al, Raney and Richter, are herein incorporated by reference.

Applicants respectfully submit that the Examiner, aware of the deficiencies of Schuetz, Raney and Richter has applied Lepper et al. in order to cure those deficiencies. Applicants respectfully submit that Lepper et al. do not cure the deficiencies of Schuetz, Raney and Richter. Since Lepper et al. neither teach nor suggest a catalyst consisting of a nickel aluminum alloy with molybdenum and/or tin up to 15%, Applicants respectfully submit that Lepper et al. do not cure the deficiencies of Schuetz, Raney and Richter. As such, Applicants respectfully request that the rejection be withdrawn.

Claims 5-8 stand rejected under 35 USC 103(a) as being unpatentable over **Diffenbach et al.** (USP 3,719,732) in view of **Lepper et al.** Applicants respectfully traverse the rejection.

Applicants respectfully submit that Diffenbach does not render the presently claimed obvious, since Diffenbach et al. fail to teach or suggest the use of a catalyst containing molybdenum and/or tin up to 15%.

The Examiner, aware of the deficiencies of Diffenbach et al., has cited Lepper et al. in order to cure these deficiencies. Since Lepper et al. has been cited for teaching that the desired particle size for a fixed bed catalyst is between 2-10 mm, Applicants respectfully submit that the Lepper et al. does not cure the deficiencies of Diffenbach. As such, Applicants respectfully request the rejection be withdrawn.

Claims 1 and 9-10 stand rejected under 35 USC 103(a) as being unpatentable over **Diffenbach et al.** in view of **Lepper** and further in view of **Schuetz et al.** Applicants respectfully traverse the rejection.

Regarding claim 1, Applicants respectfully submit that the combination of Diffenbach et al., Lepper and Schuetz et al do not render the presently claimed catalyst obvious, since Diffenbach et al., Lepper and Schuetz et al fail to teach or suggest the a step of reactivating a used catalyst.

Regarding claims 9 and 10, Applicants respectfully submit that the combination of Diffenbach, Lepper et al. and Schuetz et al. do not render the presently claimed invention obvious, since Diffenbach, Lepper et al. and Schuetz et al. fail to teach or suggest the use of a catalyst containing molybdenum and/or tin up

to 15%. As such, Applicants respectfully request the rejection be withdrawn.

Conclusion

In view of the above comments and amendments, Applicants respectfully submit that the claims are in condition for allowance. A notice to such effect is earnestly solicited.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Gath M. Dahlen (Reg. No. 43,575) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

Pursuant to 37 CFR 1.17 and 1.136(a), the Applicants respectfully petitions for a three (3) month extension of time for filing a response in connection with the present application and the required fee of \$435.00 is attached hereto.



Appl. No. 09/197,499

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

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